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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,047	01/16/2004	Mark Ehlman Scuderi	1769.1001	6142

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EXAMINER
BOZADJIAN, GEORGE D

ART UNIT	PAPER NUMBER
1792	

MAIL DATE	DELIVERY MODE
12/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/758,047	Applicant(s) SCUDERI ET AL.	
	Examiner George D. Bozadjian	Art Unit 1792	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121: See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The proposed After Final Amendment has not been entered because the applicant has no support for "wound filters" in general in the disclosure of the specification.

Response to Arguments

2. Applicant's arguments filed November 16, 2007 have been fully considered but they are not persuasive.

- a. Applicants argue, regarding the reference of Yamamoto (U.S. 6,279,587), "... the parts washer 120 shown in FIG. 2 does not include the filter 32 shown in the parts washer 10 shown in FIG. 1".

Figure 2 is an alternate arrangement of Figure 1 [col. 2, lines 18-20; col. 5, lines 1-5]. One of ordinary skill in the art would instantly envisage that filter 32 is also needed in FIG. 2, whether or not the individual draws it. In the two figures, the outlet structure, a.k.a. return tube 78 and quick-connect coupling 80, is modular and it is capable for a recycling unit to have been instantly envisaged to be placed in both outlets.

- b. Applicants argue that "other like technologies..., such as Ihringer..., do not utilize separate filter.... There is no inherent need for such a secondary filter in Yamamoto...."

The teaching of one operative recycle system (e.g. Ihringer) does not negate the teaching of another by a different reference. Yamamoto teaches that the solvent recycling system could be a filtration system or a distillation system [col. 5, lines 39-40; claim 17].

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One of ordinary skill in the art at the time the invention was made to have used the filtration system of '587 to have cleaned the recycle stream with a reasonable expectation of success (it is also inherent that filtration systems contain filters) because Yamamoto teaches that it is a suitable system to treat used paint washing solvent for further uses.

c. Applicants argue claims 2 and 3 are not supported by Yamamoto (U.S. 6,279,587), and Ihringer (U.S. 4,407,316) in view of Yamamoto (U.S. 6,279,587).

In response to applicants' argument that Yamamoto (U.S. 6,279,587) and Ihringer (U.S. 4,407,316) do not teach the limitations of claims 2 and 3, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Therefore, Yamamoto (U.S. 6,279,587) and Ihringer (U.S. 4,407,316) are capable of holding any solvents.

Additionally, applicants have provided no reason of why Yamamoto is incapable of handling such claimed solvents. The solvent is a material worked upon by the apparatus – See MPEP 2115: MATERIAL OR ARTICLE WORKED UPON DOES NOT LIMIT APARATUS CLAIMS.

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d. Applicants argue "... the combined teachings of Yamamoto (U.S. 6,279,587) and Ihringer (U.S. 4,407,316) would not result in a washing system and recycling system having filters as recited in claim 1".

Ihringer (U.S. 4,407,316) specifies solvent is being used while washing the parts and does not have the difficulty as specified or assumed by the applicants. Examiner notes applicants point at [col. 1, lines 44-49] prior art Yamamoto (U.S. 6,279,587) is aiming to solve [col. 1, lines 10-67; col. 2, lines 1-8], and the applicants' specified citation [col. 1, lines 44-49] is not Yamamoto's (U.S. 6,279,587) invention.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Yamamoto teaches that the solvent recycling system could be a filtration system or a distillation system [col. 5, lines 39-40; claim 17]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the filtration system of Yamamoto to have cleaned the recycle stream with a reasonable expectation of success, and in this case, to replace the distillation system in Ihringer with a filtration system (it is also obvious that filtration systems contain filters) because Yamamoto teaches that it is a suitable system to treat used paint washing solvent for further uses.

e. Applicants argue the solvent 2-N-methyl-pyrrolidone.

See examiner's response to "c" above.

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f. Applicants argue the integration of the pump into the control system.

Applicants' broad claim of "control system" is broad enough to include a pump.

The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art – *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

g. Applicants argue "... Ihringer (U.S. 4,407,316) does not suggest controlling ... solvent to pass through one filter as opposed to another filter".

Applicants do not claim "solvent to pass through one filter as opposed to another filter" in a broad sense. Ihringer (U.S. 4,407,316) specifies that the apparatus selectively move the solvents from washing system to recycling system [col. 2, lines 5-9]. Therefore, this meets the limitations stated in claims 8 and 9. Claim 9 does not specify "... solvent to pass through the second filter" but to not pass through the first filter.

h. Applicants argue the use of reference Robb et al. (U.S. Patent 4,793,369) and that no evidence was present in the Examiner's conclusory statement in regards to the use of KSR.

Robb et al. (U.S. Patent 4,793,369) teaches an alternate alignment of one basin over another. Yamamoto (U.S. Patent 6,279,587) teaches one way of aligning the containers while Robb et al. (U.S. Patent 4,793,369) teaches a different way, thus both are expected to be used with predictable degree of success. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have

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yielded predictable results to one of ordinary skill in the art at the time of the invention –

KSR International Co. v. Teleflex Inc.

Additionally, applicants' argument that no evidence was provided for the use of KSR is incorrect. Examiner has explained the rendered comments in the FINAL Rejection – dated 09/20/2007, as well as in this advisory action (see above).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George D. Bozadjian whose telephone number is 571-270-1871. The examiner can normally be reached on M-F 8:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on 571-272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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